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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,958	07/13/2006	Dizhong Chen	14090-00003-US1	7522

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EXAMINER

STOCKTON, LAURA LYNNE

ART UNIT	PAPER NUMBER
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1626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/572,958	Applicant(s) CHEN ET AL.	
	Examiner Laura L. Stockton	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-40 is/are pending in the application.
- 4a) Of the above claim(s) 13-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>July 13, 2006 and May 7, 2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 and 4-40 are pending in the application.

Election/Restrictions

Applicant's election of Group I (claims 1-12 - drawn to products of formula I) in the reply filed on September 15, 2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Applicant did request rejoinder if products are found allowable

The requirement is still deemed proper and is therefore made FINAL.

Claims 13-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no

allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 15, 2008.

Priority

Since the instant application claims the benefit under 35 USC § 119(e) of Provisional application 60/504,214 filed September 22, 2003 and Provisional application 60/530,890 filed December 22, 2003, the disclosures in both provisional applications were reviewed because of the possibility of intervening art. It was found that both provisional applications fail to provide adequate written description under 35 USC §112, first paragraph, for the entire scope of the instant claimed invention {i.e., see $-Z-C(=O)NR^3-OH$ group in Formula I in each of the provisional applications as well as the definitions of R^3 , X and Y}. Therefore, the

instant claimed invention can only rely on the filing date of PCT application PCT/SG2004/00307, which is September 21, 2004.

Information Disclosure Statement

The Examiner has considered the Information Disclosure Statements filed on July 13, 2006 and May 7, 2007.

Claim Objections

Claims 1 are objected to because of the following informalities: in claim 1, under the definition of R^1 , a space should be added after "-OR⁶" (page 3 of the Amendment filed September 15, 2008, line 2; page 5, line 11; and page 5, last line of page).

In claim 1, there are a number of instances where the "e" in "Each" has been capitalized but should be lower case (all occurrences). See, for instance, page 3, third line from bottom of page; page 4, line 1; page

4, line 4; etc. See the "Wherein" for same in claim 1, under the definition of L (all occurrences).

In claim 1, under the definition of Cy, "alkoxyalkyl" is misspelled (page 5, second line from bottom of page).

In claim 8, "imidazole-1-yl" is misspelled (page 7, line 9).

In claim 10, line 1, the comma after "wherein R² is" should be deleted.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 4-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, there is a valence problem when R^1 , R^2 , X or Y represent a "sulfonyl" or a R^1 or R^2 substituent is substituted by a "sulfonyl" (i.e., a divalent substituent instead of a required mono-valent substituent). See all occurrences in claim 1.

In claim 1, under the definition of R^3 , an "and" should be added before "magnesium" for proper Markush language format.

In claim 1, under the definition of X and Y, it would appear that a comma should be added before "acyl" (page 3, fourth line from the bottom of page).

In claim 1, under the definition of variable L, there are differing definitions for L^1 in the claim.

In claim 8, an "and" should be added before the last substituent listed for proper Markush language format.

In claim 9, an "and" should be added before the last substituent listed for proper Markush language format.

In claim 11, an "and" should be added before the last compound listed for proper Markush language format.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to

overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 and 4-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 85-108 of copending Application No. 12/065,989. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claimed compounds are generically claimed in the copending application.

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (C.C.P.A. 1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., histone deacetylase inhibitor).

One skilled in the art would thus be motivated to prepare products embraced by the copending application to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, inflammatory diseases. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-9 and 12 are rejected under 35

U.S.C. 102(e) as being anticipated by Bressi et al. {US 2005/0137234}.

Bressi et al. disclose, for example, Compound 90 on page 48 which is embraced by the instant claimed invention. Therefore, Bressi et al. anticipate the instant claimed invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art

are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-12 are rejected under 35
U.S.C. 103(a) as being unpatentable over Bressi et al.
{US 2005/0137234}.

***Determination of the scope and content of the prior art (MPEP
§2141.01)***

Applicant claims benzimidazole compounds. **Bressi et al.** (see entire document; particularly pages 2, 3, 6, 13, 14 and 21-27; and especially Compound 90 on page 48) teach benzimidazole compounds that are either structurally the same as (see above 102 rejection) or structurally similar to the instant claimed compounds.

***Ascertainment of the difference between the prior art and the claims
(MPEP §2141.02)***

The difference between some of the compounds of the prior art and the compounds instantly claimed is that the instant claimed compounds are generically described in the prior art.

***Finding of prima facie obviousness--rational and motivation (MPEP
§2142-2413)***

The indiscriminate selection of "some" among "many" is *prima facie* obvious, In re Lemin, 141 USPQ 814 (C.C.P.A. 1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g., histone deacetylase inhibitor).

One skilled in the art would thus be motivated to prepare products embraced by the prior art to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful in treating, for example, inflammation. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is

(571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton
Primary Examiner, Art Unit 1626
Work Group 1620
Technology Center 1600

December 25, 2008